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09/785,374	02/16/2001	Anthony M. Looper	VM 6010.2	5023

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EXAMINER

PATEL, MITAL B

ART UNIT PAPER NUMBER

3743

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 05192004

Application Number: 09/785,374
Filing Date: 16 February 2001
Appellant(s): LOOPER ET AL.

Paul E. Schaafsma and Matt E. Martin
For Appellant

MAILED
MAY 27 2004
GROUP 3700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/3/04.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 3-13, and 15-21 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,474,057

Makower et al

12-1995

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-13, and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makower et al (US 5474057).

3. **As to claim 1**, Makower teaches a surgical device comprising a tissue engaging means **15,17** and a handle assembly **34**; and an actuating means **19** connecting the handle assembly and the tissue engaging means for actuating the tissue engaging means, a shaft member comprising a first tube **11** made of a malleable material and having a proximal end, a distal end and a longitudinal axis, the proximal end of the first tube adapted to be coupled to the handle assembly, the distal end of the first tube adapted to be coupled to the tissue engaging means, the actuating means adapted to extend axially through the first tube, the first tube configured to be kink resistant and fatigue resistant and to bend about some bending radius in response to a bending moment applied to the first tube (**See Col. 7, lines 4-16**). Makower is silent to the specific range of bending moment. However, Applicant has not provided sufficient

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structure to result in structural differences between the claimed invention and the shaft of Makower and therefore, the shaft member of Makower is fully capable of bending in the range disclosed. Furthermore, it would be obvious to one of ordinary skill to provide a tube with a specific bending moment based on the intended use and function as disclosed by Makower in Col. 7, lines 4-16.

4. **As to claims 3-4**, Makower teaches essentially all of the limitations except for the specific range of the bending moment. However, the Applicant has not provided sufficient language and structure to result in structural differences between the claimed invention and the shaft of Makower, and therefore, the shaft member of Makower is fully capable of bending in the range disclosed. Furthermore, it would be obvious to one of ordinary skill to provide a tube with a specific bending moment based on the intended use and function as disclosed by Makower in Col. 7, lines 4-16.

5. **As to claims 5 and 7**, Makower teaches essentially all of the limitations except for the specifics of the wall thickness. However, it would be obvious to one of ordinary skill in the art to arrive at the particular dimensions depending on what specific medical procedure or surgical procedure the shaft member was required from since different sized tubes are used for different parts of the body when performing a surgical or medical procedure.

6. **As to claim 6**, Makower teaches a shaft member wherein the first tube is made of material selected from the group consisting of stainless steel, copper, aluminum, and brass (**See Col. 7, lines 4-16**).

7. **As to claim 8**, Makower teaches a shaft member wherein the proximal end of the first tube is adapted to be removably coupled to the handle assembly.

8. **As to claim 9**, Makower teaches a shaft member wherein the distal end of the first tube is adapted to be removably coupled to the tissue engaging means.

9. **As to claim 10**, Makower teaches a shaft member further comprising a second tube **24**, the first tube coaxially aligned and disposed within the second tube.

10. **As to claim 11**, Makower teaches a shaft member wherein the second tube is made of material selected from the group consisting of aluminum, brass, copper and plastic.

11. **As to claim 12**, Makower teaches a shaft member wherein the first and second tubes are formed from co-extrusion (**Col. 7, line 10**).

12. **As to claim 13**, Makower teaches a surgical device comprising a tissue engaging means **15** including first and second opposed jaws **17** for grasping, securing, and occluding body tissue and conduits; a handle assembly **34**, and an actuating means **19** connecting the handle assembly and the tissue engaging means for actuating the tissue engaging means, a malleable shaft member **11** comprising a first tube made of a malleable material and having a proximal end, a distal end and a longitudinal axis, the proximal end of the first tube coupled to the handle assembly, the distal end of the first tube coupled to the tissue engaging means, the actuating means extending axially through the first tube, the first tube configured to be kink resistant and fatigue resistant and to bend about some bending radius in response to a bending moment applied to the first tube (**See Col. 7, lines 4-16**). Makower is silent to the specific range of

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bending moment. However, Applicant has not provided sufficient structure to result in structural differences between the claimed invention and the shaft of Makower and therefore, the shaft member of Makower is fully capable of bending in the range disclosed. Furthermore, it would be obvious to one of ordinary skill to provide a tube with a specific bending moment based on the intended use and function as disclosed by Makower in Col. 7, lines 4-16.

13. **As to claim 15**, Makower teaches essentially all of the limitations except for the specific range of the bending moment. However, the Applicant has not provided sufficient language and structure to result in structural differences between the claimed invention and the shaft of Makower, and therefore, the shaft member of Makower is fully capable of bending in the range disclosed. Furthermore, it would be obvious to one of ordinary skill to provide a tube with a specific bending moment based on the intended use and function as disclosed by Makower in Col. 7, lines 4-16.

14. **As to claim 16**, Makower teaches essentially all of the limitations except for the specifics of the wall thickness. However, it would be obvious to one of ordinary skill in the art to arrive at the particular dimensions depending on what specific medical procedure or surgical procedure the shaft member was required from since different sized tubes are used for different parts of the body when performing a surgical or medical procedure.

15. **As to claim 17**, Makower teaches a shaft member wherein the first tube is made of material selected from the group consisting of stainless steel, copper, aluminum, and brass.

16. **As to claims 18**, Makower teaches a surgical device wherein the proximal end of the shaft member is removably coupled to the handle assembly

17. **As to claim 19**, Makower teaches a surgical device wherein the distal end of the shaft member is removably coupled to the tissue engaging means.

18. **As to claim 20**, Makower teaches a surgical device further comprising an outer tube **24**, the first tube coaxially aligned and disposed within the second tube.

19. **As to claim 21**, Makower teaches a surgical device wherein the outer tube is made of material selected from the group consisting of aluminum, brass, copper and plastic.

(11) Response to Argument

20. In response to Appellant's arguments with respect to Makower being silent to explicitly teaching of a tube that is kink resistant, fatigue resistant and bending about some bending radius, it should be noted that the disclosure in Column 7, lines 4-16 teaches that the tube "can be made out of any material appropriate for the nature of its use and in particular a medical grade plastics, metals..." Such a teaching provides sufficient motivation to one of ordinary skill in the art to make a tube as set forth by the Appellant, especially since Makower states that the tube can be made of any material suitable for a particular function. The Appellant contends that Makower teaches the use of ceramics as a material but the use of ceramics as a material is inclusive along with medical grade plastics and metals both of which exhibit bending at some bending radius. Makower does not limit the material of the tube to any particular material, ceramics or otherwise. Furthermore, malleable as defined by *The American Heritage*®

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Dictionary of the English Language, Third Edition, as "capable of being shaped or formed, as by hammering or pressure : a malleable metal." Therefore, since Makower teaches a metal as one of the materials for the tube, one would conclude that a metal is malleable since it can be shaped or formed by hammering or pressure. Furthermore, medical grade plastics are also capable of being shaped and formed under pressure, and thus are malleable materials as well.

21. In response to Appellant's arguments that Makower does not teach a kink resistant tube, it should be noted that Appellant in the specification on page 13, lines 20-21, explains that a kink resistant tube is that which when shaped or bent does not reduce the inside diameter of the shaft significantly so that cable does not bind during operation. Makower discloses in Col. 7, lines 4-16 that the tube is constructed so that it allows maximum passage while providing adequate strength. A material that provides such adequate strength or passage would not reduce significantly the inside diameter when bent or shaped and bind an actuating cable, and thus is configured to be kink resistant.

22. In response to Appellant's arguments that Makower does not teach a tube that can bend about some bending radius in response to a bending movement applied to the tube, it should be noted that Appellant broadly recites "**some** bending radius." Appellant has not particularly defined the bending radius in independent claims 1 and 13 beyond the descriptive term "some," and thus has chose to recite this term with great breadth. Accordingly, Makower discloses the tube made from medical grade plastics and metals, which would and are inherently capable of being bent at **some** bending radius.

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23. In response to Appellant's arguments that Makower does not teach a fatigue resistant tube, please note that the claims do not recite a fatigue resistant tube.

For the above reasons, it is believed that the rejections should be sustained.

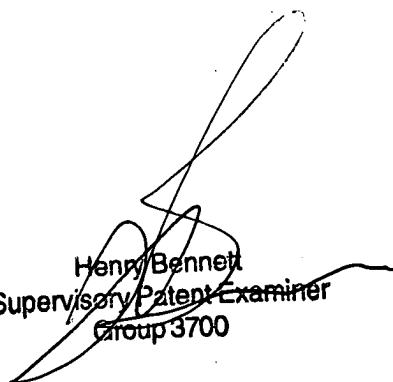
Respectfully submitted,


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Examiner
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May 21, 2004

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